

**REMARKS**

Claims 1, 5 and 7-22 are pending in this application. Claims 10-20 are withdrawn from consideration by the Examiner. By this Amendment, claims 1, 7-10, 17 and 20 are amended, new claims 21 and 22 are added, and claims 2-4 and 6 are canceled. Support for the amendments to the claims and new claims 21 and 22 can be found, for example, in the original claims. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

**I. Reference Not Considered**

As indicated in the September 30, 2005 Information Disclosure Statement, the significance of non-English language reference 4 is discussed in the instant specification (see specification at page 3, lines 16-24). Accordingly, the Examiner is requested to initial and return to the undersigned a copy of the subject Form PTO-1449 acknowledging consideration of reference 4.

**II. Restriction Requirement**

Applicants affirm the election of Group I, claims 1-9, with traverse.

Applicants respectfully submit that the Restriction Requirement is improper. Unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent

claims. In particular, it does not matter if a dependent claim itself contains a further invention.

*See also MPEP §1850(II).*

By this Amendment, claim 20 is amended to depend from independent claim 1.

Accordingly, claims 2-22 all depend from independent claim 1, and unity of invention does not need to be determined among the pending claims. The Restriction Requirement is improper.

Reconsideration and withdrawal of the restriction requirement are respectfully requested.

**III. Rejections Under 35 U.S.C. §112**

The Office Action rejects claims 7 and 9 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection.

By this Amendment, claim 7 is amended, in part, to delete “[dibutyl phthalate (DBP), diotycl phthalate (DOP), benzylbutyl phthalate (BBP), butyl butylene glycol (BPBG)]” and “[diotycle adipic acid (DOA)].” Also by this Amendment, claim 9 is amended, in part, to delete “(amine based surfactant).”

Accordingly, Applicants respectfully submit that claims 7 and 9 are not indefinite and, instead, meet the patentability requirements set forth in 35 U.S.C. §112, second paragraph. Reconsideration and withdrawal of the rejections are respectfully requested.

**IV. Rejection Under 35 U.S.C. §102**

The Office Action rejects claims 1 and 2 under 35 U.S.C. §102 as allegedly being anticipated by Sugimoto. Applicants respectfully traverse the rejection.

By this Amendment, independent claim 1 is amended to incorporate the non-rejected subject matter of claims 2-4 and 6. Thus, the rejection is overcome. Reconsideration and withdrawal of the rejection are respectfully requested.

**V. Rejections Under 35 U.S.C. §103**

**A. Sugimoto And Miyazaki**

The Office Action rejects claims 3-8 under 35 U.S.C. §103 as allegedly having been obvious over Sugimoto in view of Miyazaki. By this Amendment, claims 3, 4 and 6 are canceled, thereby rendering their rejection moot. As to the remaining claims, Applicants respectfully traverse the rejection.

As described in the specification on page 5, lines 9-10, the claimed paste allows for the formation of a print material having excellent mechanical strength and adhesiveness.

However, no reason or rationale exists for one of ordinary skill in the art to have combined the teachings of the applied references in order to produce the claimed combination of the recited limitations. Moreover, even the improper combination of the applied references would not have produced the claimed invention.

**1. No Reason Or Rationale Exists To Modify The Teachings Of The References To Produce The Claimed Combination Of the Recited Limitations**

Page 6 of the Office Action acknowledges that “Sugimoto does not teach the solvent being at least one of terpineol, dihydroterpineol, terpinyl acetate, dihydroterpinyl acetate and 4-(1’-acetoxy-1’-)cyclohexanol acetate,” as recited by claim 1. Instead, the Office Action relies on column 11, line 27 of Miyazaki for allegedly teaching “the use of terpineol as a solvent” and alleges that “it would have been obvious to one having ordinary skill in the art at the time of the invention to use a solvent such as terpineol, since it was known at the time of the invention to be used in ceramic slurries.”

However, this section of Miyazaki relied upon by the Office Action generally discloses a large "variety of organic solvents" that are merely suitable for use according to Miyazaki's invention. However, nowhere in Miyazaki is terpineol in the claimed amounts taught or suggested. Miyazaki provides no reason or rationale for one of ordinary skill in the art to have drawn from the broad disclosure of suitable organic solvents the claimed amount of the terpineol and to have combined it with other paste components as claimed in order to obtain the claimed paste. Accordingly, no reason or rationale exists for one of ordinary skill in the art to have combined the teachings of the applied references. Accordingly, the combined teachings of the applied references would not have rendered obvious claim 1 and the claims dependent therefrom.

**2. The Combination Of The Applied References Would Not Have Produced The Claimed Invention**

Page 6 of the Office Action admits that Sugimoto "does not teach a ratio of solvent of 20 to 80 parts by weight to 100 parts by weight of the ceramic powder." Instead, the Office Action relies on column 15, line 2 of Miyazaki for allegedly teaching "a ceramic slurry that uses 35 parts by weight to 100 parts by weight of ceramic powder," and alleges that it would thus have been obvious to one of ordinary skill in the art at the time of the invention to use less solvent to reduce the drying time and to improve the uniformity of the film surface.

However, claim 1 requires "a content of the solvent is 20 to 80 parts by weight with respect to 100 parts by weight of the *paste*," and not of the ceramic powder (emphasis added). Therefore, Miyazaki clearly fails to cure the deficiencies of Sugimoto, as Miyazaki fails to teach or suggest the claimed ratio of the solvent to the paste in the first place, much less teach or suggest the claimed ratio of the solvent of 20 to 80 parts by weight to 100 parts by weight of the paste, as recited in claim 1.

In fact, working examples 1 to 19 of Miyazaki describe making a paste using two different organic solvents, methyl ethyl ketone in an amount of 70 parts by weight and terpineol in an amount of 40 parts by weight. Column 16, lines 4-34. Accordingly, Miyazaki teaches using an organic solvent in an amount of 110 parts by weight to 820 parts by weight of the paste, or 13.41 parts by weight of organic solvent by 100 parts by weight of the paste, which falls outside of the claimed range. Therefore, because the combination of the applied references fails to teach or suggest at least every limitation of independent claim 1, the combination of the applied references would not have rendered obvious independent claim 1 and the claims dependent therefrom.

Reconsideration and withdrawal of the rejection are respectfully requested.

**B. Sugimoto, Miyazaki and Suzuki**

The Office Action rejects claim 9 under 35 U.S.C. §103 as allegedly having been obvious over Sugimoto in view of Miyazaki and further in view of Suzuki. Applicants respectfully traverse the rejection.

As discussed above, the combined teachings of Sugimoto and Miyazaki would not have rendered obvious independent claim 1, from which dependent claim 9 depends. Suzuki fails to cure this deficiency. In fact, page 8 of the Office Action relies on Suzuki merely for its alleged teachings that “static electricity becomes a strong influence in exfoliating the ceramic green sheet from the base material” and “using an antistatic agent such as trimethylammonium salt...to prevent damage to a ceramic green sheet, which is less than 3 microns thick, during exfoliation from a base material.” Accordingly, the combined teachings of Sugimoto, Miyazaki and Suzuki would not have rendered obvious claim 9.

Reconsideration and withdrawal of the rejection are respectfully requested.

**VI. Rejoinder**

Applicants also respectfully request rejoinder of non-elected process claims 10-20.

Where product and process claims are presented in the same application, Applicants may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.* Because process claims 10-20 include all the limitations of product claim 1, process claims 10-20 must be rejoined with the product claims when the product claims are found allowable.

Because the elected product claims are believed to be allowable for at least the reasons presented above, Applicants respectfully request withdrawal of the Restriction Requirement and rejoinder of claims 10-20.

**VII. New Claims**

By this Amendment, new dependent claims 21 and 22, which depend from independent claim 1, are added. Claims 21 and 22 are believed to distinguish over the applied references for at least the reasons discussed above with respect to claim 1. Prompt examination of claims 21 and 22 are respectfully requested.

**VIII. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of this application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: September 4, 2008

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